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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,005	03/29/2001	Michael D. Ellis	UV/189	8533
75563	7590	03/05/2008		
ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER SHEPARD, JUSTIN E	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 03/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/821,005

Applicant(s)

ELLIS ET AL.

Examiner

Justin E. Shepard

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35,38-45 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35,38-45 and 52-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Appeal Brief, filed 12/10/07, with respect to the rejection(s) of claim(s) 1, 2, 5-7, 10-17, 24-30, 33-35, 38-45, and 52-58 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Agnihotri in view of Inoue.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 7, 10-12, 24-30, 33, 35, 38-41, 43, 44, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnihotri in view of Inoue.

Referring to claim 1, Agnihotri discloses a method for use in a recording system for reducing cut-offs when programs are recorded (column 3, lines 36-45), the method comprising:

receiving at the user equipment a user selection of a program to record (column 1, lines 16-20);

predicting by the user equipment a time change associated with the program (column 3, lines 36-45 and 59-63; column 4, lines 6-14);

recording by the user equipment the program to compensate for a time change based on the predicted time change (column 5, lines 20-32).

Agnihotri does not disclose a system wherein the time change is based on time changes for previous programs related to the program.

In an analogous art, Inoue teaches a system wherein the predicted time change is based on time changes for previous programs related to the program (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 29 is rejected on the same grounds as claim 1.

Referring to claim 2, Agnihotri discloses a method of claim 1 wherein the predicted time change comprises predicted time delay information (column 3, lines 36-45).

Claim 30 is rejected on the same grounds as claim 2.

Referring to claim 5, Agnihotri discloses a method of claim 2 wherein the predicted time delay information is based on previously logged time changes (column 8, lines 5-13).

Claims 10 and 33 are rejected on the same grounds as claim 5.

Referring to claim 6, Agnihotri does not disclose a method of claim 1 further comprising displaying a predicted time delay information for the program.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying a predicted time delay information for the program (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Claim 34 is rejected on the same grounds as claim 6.

Referring to claim 7, Agnihotri discloses a method of claim 1 wherein the predicted time change comprises predicted time extension information (column 3, lines 36-45).

Claims 11 and 35 are rejected on the same grounds as claim 7.

Referring to claim 12, Agnihotri discloses a method of claim 1 further comprising providing a user with an opportunity to select a recording start time (column 1, lines 16-20).

Referring to claim 15, Agnihotri discloses a method of claim 1 further comprising providing a user with an opportunity to select a recording end time (column 1, lines 16-20).

Referring to claim 24, Agnihotri does not disclose a method of claim 1 further comprising displaying an icon in a program listing for the program to indicate that the predicted time change is available.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying an icon in a program listing for the program to indicate that the predicted time change information is available (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Claim 52 is rejected on the same grounds as claim 24.

Referring to claim 25, Agnihotri does not disclose a method of claim 1 further comprising displaying an icon in a program listing for the program that indicates that the program is to be recorded.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying an icon in a program listing for the program that indicates that the program is to be recorded (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Claim 53 is rejected on the same grounds as claim 25.

Referring to claim 26, Agnihotri does not disclose a method of claim 1 further comprising trimming a recording time of the scheduled program or an adjacent program to reduce the cut-off in a program recording.

In an analogous art, Inoue teaches a method of claim 1 further comprising trimming a recording time of the scheduled program or an adjacent program to reduce the cut-off in a program recording (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 54 is rejected on the same grounds as claim 26.

Referring to claim 27, Agnihotri discloses a method of claim 26 wherein trimming the recording time comprises trimming based on a confidence level in time change

information for the scheduled program and the adjacent program (column 7, lines 54-61).

Claim 55 is rejected on the same grounds as claim 27.

Referring to claim 28, Agnihotri discloses a method of claim 27 wherein trimming comprises trimming a time changed recording time of the scheduled program when time change information for the scheduled program has a lower confidence level than the adjacent program (column 7, lines 54-61; column 8, lines 22-27).

Claim 56 is rejected on the same grounds as claim 28.

Referring to claim 40, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry provides a user with an opportunity to select a recording start time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry provides a user with an opportunity to select a recording start time to compensate for the time change (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).



Referring to claim 41, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording start time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording start time to compensate for the time change (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Referring to claim 43, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry provides the user with an opportunity to select a recording end time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry provides the user with an opportunity to select a recording end time to compensate for the time change (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Referring to claim 44, Agnihotri discloses a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording end time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording end time to compensate for the time change (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Referring to claim 57, Agnihotri discloses a method of claim 1 further comprising allowing the user to change the predicted time change (column 8, lines 22-27).

Claim 58 is rejected on the same grounds as claim 57.

Claims 13, 14, 16, 17, 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnihotri in view of Inoue as applied to the claims above, and further in view of Hoffberg.

Referring to claim 13, Agnihotri and Inoue do not disclose a method of claim 1 further comprising automatically selecting the recording start time.

In an analogous art, Hoffberg teaches a method of claim 1 further comprising automatically selecting the recording start time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Referring to claim 14, Agnihotri and Inoue do not disclose a method of claim 13 further comprising providing a user with an opportunity to select to have automatic selection of the recording start time.

In an analogous art, Hoffberg teaches a method of claim 13 further comprising providing a user with an opportunity to select to have automatic selection of the recording start time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Claim 42 is rejected on the same grounds as claim 14.

Referring to claim 16, Agnihotri and Inoue do not disclose a method of claim 1 further comprising automatically selecting the recording end time.

In an analogous art, Hoffberg teaches a method of claim 1 further comprising automatically selecting the recording end time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Referring to claim 17, Agnihotri and Inoue do not disclose a method of claim 16 further comprising providing a user with an opportunity to select to have automatic selection of the recording end time.

In an analogous art, Hoffberg teaches a method of claim 16 further comprising providing a user with an opportunity to select to have automatic selection of the recording end time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Claim 45 is rejected on the same grounds as claim 17.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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